

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO SAITO,
SYUJI HAGIHARA
and HIROKI NAKAYAMA

Appeal No. 1998-2775
Application 08/574,544

HEARD: May 3, 2000

Before MCCANDLISH, Senior Administrative Patent Judge, STAAB
and GONZALES, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 5 through 11. The rejection of claim 11 as set forth in the final office action (Paper No. 6 mailed April 17, 1997) has not been carried forward and restated in the examiner's answer (Paper No. 13, mailed

November 25, 1997). It therefore is presumed that the rejection of claim

11 has been withdrawn as a result of the amendment filed with appellants' main brief. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957). Although the examiner has not notified appellants about the current status of claim 11, it appears that this dependent claim is considered to be allowable subject to being rewritten in independent form. Based on this understanding of the record before us, the only issues remaining in this appeal involve the examiner's rejections of claims 5 through 10.

Appellants' claimed invention relates to an artificial leg having a thigh section (21) and a lower leg portion (1) pivotally connected to the thigh section by a knee joint structure (4, 12, 17, 19). According to claim 6, the only independent claim on appeal, the knee joint structure comprises a bearing part (17) having what is defined as a "third stopper portion" (16).¹ The third stopper portion is

¹ The bearing part 4 is described in appellants' specification as having two portions 7 and 15 integrally joined to each other. Appellants' drawings show that only portion 7 is embedded in the lower leg portion in the sense that it is received in an aperture 2 in the lower leg

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engagable with a first stopper portion (9) to limit rotation of the lower leg portion in one direction to a standing position. The third stopper portion is also engagable with a second stopper portion (10) to limit rotation of the lower leg portion in the opposite direction to a kneeling position.

A copy of the appealed claims is appended to appellants' brief.

The following reference is relied upon by the examiner in support of his rejections under 35 U.S.C. § 103 and 35 U.S.C. § 102(b):

Lewis

278,566

May 29, 1883

Appealed claims 6 through 10 stand rejected under

portion. In contrast, claim 6 recites that the bearing part is embedded in the lower leg portion as if the entire bearing part is received in an aperture in the lower leg portion. Consistent with appellants' original disclosure we have therefore interpreted clause "c" of claim 6 as meaning that the bearing part has a portion embedded in the lower leg portion. Correction of this informality is in order upon return of this application to the examiner.

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35 U.S.C. § 102(b) as being anticipated by Lewis, and appealed claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lewis. Appealed claim 5 additionally stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Considering first the § 102(b) rejection of claim 6, Lewis discloses an artificial leg having a thigh section A and a lower leg portion D attached to the thigh section by a pair of strap assemblies. Each strap assembly in Lewis' artificial leg has pivotally interconnected upper and lower metal straps E and F to allow pivotal movement between the thigh section and the lower leg portion. The upper straps E of the two strap assemblies are fastened to the thigh section. The lower straps F of the strap assemblies are attached to the lower leg portion. Contrary to appellants' arguments, the lower straps F are considered to be embedded in the lower leg portion in that they appear from the showing in Figure 1 of Lewis' drawings to be received in upwardly opening pockets in the lower leg portion.

In each of Lewis' strap assemblies, an arcuate portion on the lower end of the upper strap E seats on and is capable of articulating about a generally circular portion at the upper end of the lower strap F to provide a hinged joint e as shown in Figures 3 and 4 of Lewis' drawings. The arcuate portion on the lower end of the upper strap E lies circumferentially between two circumferentially opposed, radially extending shoulders on the circular portion at the upper end of the lower strap F. The end e' of the arcuate portion is described as a stop and is engagable with the opposing shoulder on the generally circular portion of the lower strap F to limit clockwise rotation of the upper strap E to a generally vertical standing position as shown in Figure 3.

There is no description, however, about the other circumferential shoulder. In particular, Lewis' specification lacks a disclosure that the other circumferential shoulder provides a stop for limiting counterclockwise rotation of the upper strap E (as viewed from Figure 3 of Lewis' drawings) in a kneeling position.

The examiner takes the position, in substance, that the other, unlabeled circumferential shoulder will inherently act as a stop to limit rotation of the upper strap **e** to a kneeling position. The examiner's reasoning follows:

The Lewis specification, contrary to the Appellant's [sic] comments, very plainly provides support for the Examiner's position that the thigh socket **A** is flexible enough to permit the shoulders of the joint **e** to contact one another at full flexion. If the "sole-leather" is "of sufficient elasticity to adapt itself to the shape of the limb" (lines 30-32), then it will certainly offer little if any resistance to a contacting wooden leg member **D**. [Answer, page 5.]

Admittedly, the upper strap **E** may be capable of rotation in a counterclockwise direction to a position where the arcuate portion on the upper strap abuts the unlabeled circumferential shoulder on the generally circular portion of the lower strap so that the unlabeled shoulder acts as a stop. However, as stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), inherency may not be established by possibilities or even probabilities. Instead, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination

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that the allegedly inherent features necessarily flow from the teachings of the applied reference. See Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) and cases cited therein.

In the present case, it does not necessarily flow from Lewis' disclosure that Lewis' upper strap E is inherently capable of rotation to a position where the unlabeled circumferential shoulder on the generally circular portion acts as a stop for the reasons stated by appellants on pages 6 and 7 of the main brief. Accordingly, we are constrained to reverse the § 102(b) rejection of claim 6 and the § 102(b) rejection of dependent claims 7 through 10 since Lewis does not expressly or inherently meet all of the limitations in claim 6. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.).

We also cannot sustain the § 103 rejection of dependent claim 5. The examiner has not supplied any motivation to establish that it would have been obvious to enable Lewis'

upper strap E to be rotated sufficiently far in a counterclockwise direction to engage the unlabeled circumferential shoulder on the generally circular portion of the lower strap F.

With regard to the rejection of claim 5 under the second paragraph of § 112, appellants contend in their reply brief that the examiner has raised a new basis for this rejection in his answer. However, appellants have not challenged the grounds set forth in the answer. Instead appellants merely state in the reply brief that they are "prepared to amend claim 5" (reply brief, page 1). Thus, appellants have not pointed out how the examiner erred in this rejection. We will therefore sustain the § 112, second paragraph, rejection of claim 5.

In summary, we have reversed the § 102(b) rejection of claims 6 through 10, reversed the § 103 rejection of claim 5 and affirmed the § 112, second paragraph, rejection of claim 5.

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The examiner's decision rejecting the appealed claims
is affirmed in part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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